

Lamb
Serial No. 10/062,954
Filed: January 31, 2002

Remarks

The Final Office Action mailed January 28, 2004, has been fully considered by the Applicants. In view of the above amendments and following remarks, withdrawal of the objections and rejections and issuance of a Notice of Allowance is respectfully requested.

Applicants submit the amendments to the claims do not raise new matter, as support for the amendments may be found in the specification and claims as filed.

A telephone interview with the Examiner was held on May 21, 2004. Participating in the interview with Examiner Lucas were Examiner James Housel, the inventor, Dr. Blair Lamb; his colleague, Grant Fairly; Marcia Greci (Registration Number 54,717) of Summa & Allan, P.A., Charlotte, North Carolina and Ursula McGuinness of Gowling Lafleur Henderson LLP, Hamilton, Canada. Agreement was reached to amend claim 9 as shown above. Agreement was also reached that the method of the present invention provides an unexpected beneficial result, as evidenced by the attached Rule 132 declaration.

Claims 25-27 have been amended to correct dependency. Claims 1-8, 10-20, and 23 are cancelled without prejudice or disclaimer.

The Examiner has objected to claims 21, 29, and 30 as containing various informalities. The claims have been amended to insert commas as suggested by the Examiner. The objections have thus been overcome and removal of the objections is requested.

Claims 9 and 21-27 are not obvious over Donovan and Aoki in view of Share and Borodic

Claims 9 and 21-27 were rejected under 35 U.S.C. § 103(a) as being unpatentable over the teachings of Donovan and Aoki, and further in view of Share and Borodic. Applicants traverse.

Claim 9 has been amended in accordance with the agreement reached during the phone interview of May 21, 2004. As agreed, there is no teaching or suggestion within any of Donovan, Aoki, Borodic, or Share that would lead one of skill in the art to the combine the references and modify the resulting combination by directly and solely injecting the intrinsic muscles. Moreover, such an injection provides the unexpected results outlined in the attached Rule 132 declaration by Dr. Blair Lamb. Accordingly, claim 9 and claims 21-27, dependent

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from claim 9, are in condition for allowance. Withdrawal of the rejections is respectfully requested.

Claims 26 and 27 are not obvious over Donovan, Aoki, Borodic, and Share, and further in view of Moyer

The Examiner has rejected claims 26 and 27 as being unpatentable over Donovan, Aoki, Borodic, and Share, and further in view of Moyer. The rejection is traversed.

Applicants respectfully submit that even were the combination suggested by the Examiner to be made, it would not result in the presently claimed method. Specifically, there is no teaching or suggestion in any of the cited references that would lead one of skill in the art to make the proposed combination and then modify that combination by directly and solely injecting the intrinsic muscles as claimed in present claim 9. This conclusion was verified in the telephone interview of May 21, 2004. Claims 26 and 27, dependent from claim 9, are also, therefore, patentably distinct and withdrawal of the rejections is requested.

Claim 28 is not obvious over Donovan, Aoki, Borodic, and Share, and further in view of DeSimone or Ferree

Claim 28 is rejected under 35 U.S.C. §103(a) as being unpatentable over Donovan, Aoki, Borodic, and Share, and further in view of DeSimone or Ferree. Applicants respectfully traverse.

As agreed in the telephone interview, amended claim 9 is not obvious in view of Donovan, Aoki, Borodic, and Share. There is no teaching or suggestion in any of the cited references that would lead one of skill in the art to combine the cited references and then modify those references as would be necessary to achieve the method of claim 28, which is dependent from claim 9. Specifically, there is no teaching or suggestion that would lead one of skill in the art to modify the combination by directly injecting the botulinum toxin into the intrinsic muscles. Accordingly, the rejections should be withdrawn.

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Claim 30 is not obvious over the combined teachings of Donovan, Aoki, Borodic, and Share in view of Yamada

The Examiner has rejected claim 30 as being unpatentable under 35 U.S.C. § 103(a) over the combined teachings of Donovan, Aoki, Borodic, and Share, and further in view of the teachings of Yamada. The rejection is traversed.


According to the Examiner, the claim reads on a method of treating spinal compression. As agreed in the telephone interview of May 21, 2004, none of Donovan, Aoki, Borodic, or Share teach or suggest directly and solely injecting intrinsic muscles. Nor does Yamada teach or suggest the direct injection of intrinsic muscles. Without such teaching or suggestion, there is no motivation that would lead one of skill in the art to make the proposed combination and then modify that combination to achieve the presently claimed method. Accordingly, the claims are not obvious over the cited references. Withdrawal of the rejections is requested.

Conclusion

Applicants submit that in view of the above amendments and remarks, the application is in condition for allowance. Withdrawal of the rejections and objections and issuance of a Notice of Allowance is respectfully requested.

It is believed that no additional fees are due in conjunction with the filing of this response and request for a one-month extension of time. If, however, it is determined that additional fees are due, withdrawal of those fees from Deposit Account No. 50-0332 is hereby authorized.

Respectfully submitted,


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